

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
SALA *et al.*

Appl. No.: 10/046,724

Filed: January 17, 2002

For: **System and Method for a Generalized
Packet Header Suppression Mechanism**

Confirmation No.: 2556

Art Unit: 2616

Examiner: Park, Jung H.

Atty. Docket: 1875.0710001

Petition to the Director Under 37 C.F.R. § 1.181

Attn: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Mail Stop: Petition

Dear Sir:

Applicants respectfully petition the Director to withdraw the finality of the final rejection, dated April 12, 2007 and reopen prosecution in the above referenced matter to permit entry of the claim amendments filed on September 12, 2007. The Examiner improperly issued a Final Office Action when (a) the Examiner did not address the Applicants' arguments with respect to the rejection of a dependent claim when the dependent claim was placed in independent form, and (b) the Examiner did not apply a new ground of rejection to the dependent claim when it was placed in independent form.

SUMMARY OF FACTS

Original Claim 9 claimed, "The method of claim 1, wherein said descriptor table includes a parser specification sub-table, an expansion sub-table and a mask specification sub-table." Original Claim 19 claimed "The system of claim 12, wherein said descriptor table includes a parser specification sub-table, an expansion sub-table and a mask specification sub-table."

In the Non-Final Rejection mailed July 25, 2006 the Examiner rejected claims 9 and 19 under 35 U.S.C. 103(a) as being unpatentable over Chapman et al. U.S. Patent 6,348,123 ("Chapman") in view of U.S. Published Patent Application 2002/0065907 ("Cloonan").

In the Amendment and Reply under C.F.R. §1.111 dated January 25, 2007 Applicants canceled claim 9 and amended claim 1 to include the subject matter of claim 9. Applicants also canceled claim 19 and amended claim 12 to include the subject matter of claim 19. Additionally, Applicants argued the patentability of amended claims 1 and 12 over Chapman in view of Cloonan.

In the Final Rejection mailed April 16, 2007 the Examiner rejected claims 1 and 12 under 35 U.S.C. 103(a) as being unpatentable over Chapman in view of Cloonan by copying the Examiner's previous arguments in the non-final rejection. In the ***Response to Arguments*** section of the Final Rejection mailed April 16, 2007 the Examiner stated "Applicant's arguments with respect to claims 1 and 12 have been considered but are moot in view of the new ground(s) of rejection." In the ***Conclusion*** section of the Final Rejection mailed April 16, 2007 the Examiner stated "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly **THIS ACTION IS MADE FINAL.**"

In the Amendment and Reply under C.F.R. §1.116 dated September 12, 2007 Applicants argued "Because the amendments to claims 1 and 12 did not change the scope of the originally examined subject matter, the amendments could not have necessitated the new grounds of rejection. As provided by MPEP § 706.07, if an Examiner is not using a new ground of rejection, a final rejection should include a rebuttal of any arguments raised in the Applicant's reply. In the Office Action the Examiner did not

provide a rebuttal to the Applicants' arguments, but instead rendered the arguments moot on the basis of the new grounds of rejection."

The Advisory Action mailed October 3, 2007 failed to address the appropriateness of Final Rejection mailed April 16, 2007 or withdraw the Final Rejection mailed April 16, 2007. Furthermore, the Examiner refused to enter amendments that included incorporating allowable subject matter into the independent claims to place the claims condition for allowance.

On October 10, 2007, Applicants' representatives contacted the Examiner. The Examiner agreed that the claims that had not been entered would be allowable. The Examiner indicated that he would check with the Examiner's SPE whether he could reopen prosecution and provide a Notice of Allowance. The Examiner indicated that his SPE rejected this proposal.

POINT TO BE REVIEWED

The Office Action, dated Apr. 12, 2007, was improperly made final. Applicants request that the Director review this point, and withdraw the finality of the office action and reopen prosecution. As stated above, because the claim amendments to claims 1 and 12 did not change the scope of the originally examined subject matter, the amendments could not have necessitated the new grounds of rejection. Existing elements from dependent claims were simply incorporated into independent claims, and the Examiner did not address the applicants' arguments with respect to the grounds for rejection. Thus, providing a final office action was improper. The specific sequence of events for review in this case are as follows:

(1) in the non-final office action, the Examiner applied a Ground of Rejection to a dependent claim;

(2) in response to the non-final office action, the Applicants canceled the dependent claim and incorporated the subject matter thereof into its independent claim and argued the Ground of Rejection;

(3) in the final office action, the Examiner applied the Ground of Rejection to the independent claim incorporating the canceled dependent claim;

(4) In the final office action, the Examiner failed to address the applicants' arguments with respect to the Ground of Rejection; and

(5) in the final office action, the Examiner maintained that applying the Ground of Rejection to the independent claim incorporating the canceled dependent claim is a new ground of rejection.

ACTION REQUESTED

Applicants respectfully request that the Director determine that the finality of the April 12th, 2007 office action was improper, and reopen prosecution of the above application.

Respectfully submitted,

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